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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,093	11/20/2003	Herman Rodriguez	AUS920030912US1	9415
35525	7590	12/12/2007	EXAMINER	
IBM CORP (YA)			SAFAIPOUR, HOUSHANG	
C/O YEE & ASSOCIATES PC				
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			12/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/718,093

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Houshang Safaipoor

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☒ Claim(s) 1,3-5, 7 and 9-21 is/are rejected.
- 7) ☒ Claim(s) 2,6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

The recitation regarding “An automatic teller machine...” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

#### ***Claim Objections***

Claim 1 is objected to because the term “a user” has been recited in the first and fourth limitations. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Antognini et al. (US 2002/0023055).

Regarding claim 1, Antognini discloses an automatic machine, comprising:

a first input receiver for receiving input from a user (user placing paper payment instrument into the facsimile machine [0066]);

a second input receiver for receiving input from the user (user manually entering a telephone number [0066];

a communication system capable of sending a facsimile to a remote location [0066];

wherein a user designates a facsimile number and causes a payment instrument to be sent by facsimile to the remote location [0066].

Regarding claim 3, Antognini discloses the machine of claim 1, wherein the second input receiver comprises an alpha-numeric keypad [0066].

Regarding claim 4, Antognini discloses the machine of claim 1, wherein the payment instrument is "paper payment instrument" [0066].

Regarding claim 5, Antognini discloses the machine of claim 1,, wherein the remote location is a payee [0066].

Regarding claim 7, Antognini discloses the machine of claim 1, wherein the facsimile is sent from a second remote location [0066].

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini et al. (US 2002/0023055).

Regarding claims 9 and 15, Antognini discloses that a bill payer at ATM machine is presented with an option of paying his bills [0062]. Antognini also discloses that the ATM is capable of initiating a process where a physical check is issued and sent to the bill presented, through the mail or otherwise [0063]. Therefore if the payer selects payment via fax, the physical check can be faxed by using the method as described as "fourth choice for payment" as described in paragraph [0066].

Regarding claim 13, Antognini discloses the method of claim 9, wherein the step of sending the payment instrument includes sending a request to a remote location (server), wherein the remote location sends the payment instrument [0066].

Regarding claims 10 and 16, Antognini discloses the method of claim 15, wherein the step of receiving payment for the payment instrument comprises debiting an account of the user [0062].

Regarding claims 11 and 17, Antognini discloses the method of claim 15, wherein the step of receiving payment for the payment instrument comprises receiving cash input by the user into the automatic teller machine [0062].

Regarding claim 18, Antognini discloses the method of claim 15, wherein the step of sending the facsimile includes sending a request to a remote location (server) to send the facsimile to the designated payee [0066].

Regarding claim 19, Antognini discloses the method of claim 15, wherein the step of sending the facsimile further comprises receiving a designation of a facsimile number from the user [0066].

Regarding claims 12 and 20, Antognini discloses the method of claim 15, wherein the payment instrument is selected from the group consisting of: a cashier's check, a money order and a personal check [0063].

Regarding claims 14 and 21, Antognini discloses the method of claim 15, further comprising the step of printing a receipt of the payment instrument [0064].

*Allowable Subject Matter*

5. Claims 2, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22 is allowed. The prior art does not disclose an automatic teller machine comprising: "...a sending means for sending the facsimile from a second remote location when the automatic teller machine is incapable of sending a facsimile, wherein a request to send a facsimile is sent from the automatic teller machine to a remote machine at the second remote location, and wherein the remote machine causes the facsimile to be sent; a charging means, responsive to the sending of the facsimile, for charging a user account for the payment instrument; and an output means for presenting to the user at least one of a payment instrument and a proof of the transaction."

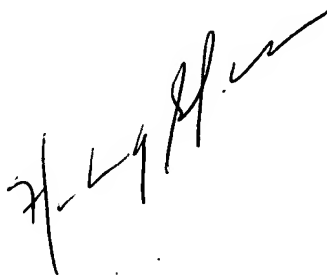
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Houshang Safaipoor  
Patent Examiner  
November 30, 2007

A handwritten signature in black ink, appearing to read 'H. Safaipoor', is written diagonally across the lower right portion of the page.